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EXAMINER

HOYE, MICHAEL W

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 04/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,824

Applicant(s)

GUREVICH ET AL.

Examiner

Michael W. Hoye

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicants' arguments filed on 2/25/05 have been fully considered but they are not persuasive.

Regarding independent claims 1, 8 and 17, the Applicants argue on page 9 of the Remarks that, "the prior art references of record, whether considered alone, or in combination, fail to either teach or suggest Applicants presently claimed invention." More specifically, on page 10, the Applicants argue that the independent claims have been modified to reflect, "recording of the time and channel being viewed and data is matched with a particular offer for the requested information. [And...] the references of record fail to teach or suggest this advance in the art."

Also, in the second paragraph in page 10 of the Remarks, the Applicants argue that:

"In contrast [to Ellis et al. (US 2003/0149988)], the present invention allows a user to order audio or video data which is offered in a video broadcast. Specifically, it allows a user to signal the set-top box that he or she wishes to order the offered audio or video data. This advantageously allows a user to order audio or video data without interrupting his or her viewing experience by precluding the user from having to access an IPG, select a program listing, and then request that the same be recorded."

In response, the Examiner respectfully disagrees with the Applicants because the Ellis et al reference discloses the amended claim language including, "receiving an order for audio or video data based on a user selection made while viewing a broadcast through a video viewing system," as met by the end of ¶ [0133] and the top of page 12, where users may indicate a desire to record a program or group of programs on demand by, for example, pressing a "RECORD"

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key on remote control 40 while watching a program (see pgs. 11-12, ¶'s [0133] - [0134] and Fig. 14a). And the claimed, "matching the recorded time and channel to identify the desired audio or video data," is met by the user indicating a desire to order or record as program, where the set-top box 28 transmits the information or a record request to the head-end and server or appropriate media server, and the information or record request (order) may include information related to the program and the user, including the time and channel being viewed by the user (see pg. 6, ¶ [0087], pg. 7, ¶ [0091], pgs. 11-12, ¶'s [0133] - [0134] and pg. 12, ¶ [0142]), in order to retrieve and transmit the requested audio or video data to the user.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) and 37 CFR 1.84(o) because they fail to show text labels of the parts or features as described in the specification (i.e. "Server 110"). Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claims 2-3 and 18-19 are objected to because of the following informalities: claims 2 and 18 are listed as "(Withdrawn)", however, claims 3 and 19 are listed as dependent upon claim 2 and claim 18 respectively. The Examiner is unsure whether or not claims 2 and 18 have been canceled, and if claims 2 and 18 have been canceled, the claims would be dependent upon claim

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1 and claim 17 respectively. Otherwise, the indication that claims 2 and 18 are “Withdrawn” is incorrect. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, 5 and 8-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al (US 2003/0149988 A1), cited by the Examiner.

As to claim 1, note the Ellis et al reference which discloses the claimed method of “receiving an order for audio [and/] or video data based on a user selection made while viewing a broadcast through a video viewing system” as met in one example by user television equipment 22 (Fig. 7), including a set-top box 28, a television 36, and a remote control 40, where a user highlights a program, such as “I Love Lucy” (Fig. 11a), and selects the “record” button on the remote control 40 (also see Figs. 14a-b and pgs. 11-12, ¶ [0133]-[0134]), or by the user highlighting a pay-per-view program listing and pressing “order” or another suitable key on the remote control 40 (see Fig. 15a and pg. 12, ¶ [0138]), or more specifically at the end of ¶ [0133] and the top of page 12, where users may indicate a desire to record a program or group of programs on demand by, for example, pressing a “RECORD” key on remote control 40 while watching a program (see pgs. 11-12, ¶’s [0133] - [0134] and Fig. 14a). The claimed, “wherein

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the step of receiving the order comprises recording a time and channel being viewed by the user,” is met by the user indicating a desire to order or record as program, where a record request is transmitted to the appropriate media server, and the record request or order may include information related to the program and the user including the time and channel being viewed by the user (see page 6, ¶ [0087], pages 11-12, ¶’s [0133] - [0134] and page 12, ¶ [0142]). The claimed “transmitting the order from the video viewing to a data storage device” is met by the set-top box 28 transmitting the request or order to the remote media server 24, which comprises a server 24 (and 25) and data storage 15 (see Figs. 7 and 2a-2e, and pg. 7, ¶ [0091] for example). The claimed, “matching the recorded time and channel to identify the desired audio or video data,” is met by the user indicating a desire to order or record as program, where the set-top box 28 transmits the information or a record request to the head-end and server or appropriate media server, and the information or record request (order) may include information related to the program and the user, including the time and channel being viewed by the user (see pg. 6, ¶ [0087], pg. 7, ¶ [0091], pgs. 11-12, ¶’s [0133] - [0134] and pg. 12, ¶ [0142]), in order to retrieve and “transmit the requested audio or video data to the user”, which is met by the programs or videos may be distributed by distribution equipment 21 to user television equipment 22 in various formats, such as MPEG-2 files, an MPEG-2 data stream, or other formats (see pg. 7, ¶ [0097]).

As to claims 2 and 3, the claimed “order for data is stored by the video viewing system for transmission to a head-end by noting a time and channel viewed when signaled by the user” is met as previously described above in claim 1 where the set-top box 28 transmits the

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information to the head-end and server, where the information includes time(s), channel viewed, a user number or identification, and other information (see pg. 6, ¶ [0087]).

As to claim 5, the Ellis et al reference discloses that the claimed “order for data” may be added to a communication between the video viewing system (22) and a server (24) regulating the broadcast received via a communication medium (20) (see pgs. 8-9, ¶ [0105]-[0107] and Figures 2a-2e, 7 and 9).

As to claim 8, note the Ellis et al reference which discloses a video viewing system (user TV equipment 22, see Figs. 2a-2e and 7) for displaying video programs (television 36, Fig. 7) and receiving orders for audio or video data offered in a broadcast (remote control 40, see Figs. 7 and 8), where a user highlights a program, such as “I Love Lucy” (Fig. 11a), and selects the “record” button on the remote control 40 (also see Figs. 14a-b and pgs. 11-12, ¶ [0133]-[0134]), or by the user highlighting a pay-per-view program listing and pressing “order” or another suitable key on the remote control 40 (see Fig. 15a and pg. 12, ¶ [0138]), or more specifically at the end of ¶ [0133] and the top of page 12, where users may indicate a desire to record a program or group of programs on demand by, for example, pressing a “RECORD” key on remote control 40 while watching a program (see pgs. 11-12, ¶’s [0133] - [0134] and Fig. 14a). The claimed, “wherein the system for receiving orders includes a means for recording a time and channel being viewed by the user when ordering,” is met by the user indicating a desire to order or record as program, where a record request is transmitted to the appropriate media server, and the record request or order may include information related to the program and the user including the time and channel being viewed by the user (see page 6, ¶ [0087], pages 11-12, ¶’s [0133] - [0134] and page 12, ¶ [0142]). The claimed, “server for receiving and processing orders for audio or video

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data,” is met by server 24 (Figs. 2a-2e), and the claimed, “means for matching the recorded time and channel to identify the desired audio or video data,” is met by the user indicating a desire to order or record as program, where the set-top box 28 transmits the information or a record request to the head-end and server or appropriate media server, and the information or record request (order) may include information related to the program and the user, including the time and channel being viewed by the user (see pg. 6, ¶ [0087], pg. 7, ¶ [0091], pgs. 11-12, ¶’s [0133] - [0134] and pg. 12, ¶ [0142]), in order to retrieve and transmit the requested audio or video data to the user. The claimed “communications medium between the video viewing system and the server” and “link between the server and the viewer...” is met by the video and data input 26 in Fig. 7 (pg. 8, ¶ [0098]) or communications path 20 (see Figs. 2a – 2d), and the claimed “delivery of the audio or video data in a portable electronic form” is met by the programs or videos may be distributed by distribution equipment 21 to user television equipment 22 in various formats, such as MPEG-2 files, an MPEG-2 data stream, or other formats (see pg. 7, ¶ [0097]).

As to claim 9, the Ellis et al reference discloses the claimed “set top box” (see 28, Fig. 7) and “a video viewing media” (see television 36).

As to claim 10, the claimed “video viewing system includes a cursor control which allows a user to signal selection by placing the cursor in a specific area, or “hot” area, of the viewing medium’s screen” is met by a user positioning highlight region, such as 151 (see Figs. 10 and 11a-c), over a desired program guide option related to program listings by manipulating the user input device 46 (see pg. 10, ¶ [0121], [0123] and [0116]).

As to claim 11, the claimed “video viewing system includes a remote control with an “activate” button, which signals selection of an audio or video data program” is met by the user

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pressing a "RECORD" key on remote control 40 after highlighting a programs listing (see Fig. 8, pg. 11, end of ¶ [0133] and [0134]) or by the user highlighting a pay-per-view program listing and pressing the "order" or other suitable key on remote control 40 (see pg. 12, ¶ [0138]).

As to claim 12, the Ellis et al reference discloses that the claimed "order for data" may be added to a communication between the video viewing system (22) and a server (24) regulating the broadcast received via a communication medium (20) (see pgs. 8-9, ¶ [0105]-[0107] and Figures 2a-2e, 7 and 9).

As to claim 13, Ellis et al discloses the claimed "more than one server and mass data storage unit service the video viewing system" as met by remote media server 24, storage 15, Internet service system 61, and program guide server, which are all a part of the distribution facility 16 (Fig. 2d).

As to claim 14, the claimed "requested data is transmitted via a broadcast system to the user's video viewing system" is met by the requested data being transmitted via a communications paths 20 (see Figs. 2a-2d and 9), which may include, for example, a satellite link, a telephone network link, a cable or fiber optic link, a microwave link, an Internet link, a data-over-cable service interface specification (DOCSIS) link, a combination of links, or any other suitable communications link (see pg. 4, ¶ [0064]-[0065]) to the user television equipment 22/set top box 28 (pg. 5, ¶ [0075]).

As to claim 15, the claimed "video viewing system includes an audio or video file player that can download the audio or video data from a port" is met by digital storage device 31, which can be an external device connected to set-top box 28 via an output port and appropriate interface (see Fig. 7 and pg. 8, ¶ [0102]). The digital storage device 31 may be a DVD player capable of

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handling recordable DVD disks, or may be various other players and storage devices (pg. 8, ¶ [0101]). The video viewing system (user television equipment 32) also may include a secondary storage device 32 (see pg. 8, ¶ [0098], [0100] and [0104]).

As to claim 16, the claimed “video viewing system includes a removable memory media that stores the audio or video data” is met by digital storage device 31 and/or secondary storage device 32, as previously described above in claim 15, which may include DVD disks or various other removable memory media.

As to claim 17, note the Ellis et al reference which discloses the claimed “machine-readable storage medium...” as met by memory 63, which may be any memory or other storage device, such as a random access memory (RAM), read only memory (ROM), flash memory, a hard disk drive, a combination of such devices, etc., that has stored program guide application instructions and other data for use by control circuitry 42 for execution by the user television equipment 22, such as set-top box 28 (see Figures 7 and 9, and pg. 9, ¶ [0112]-[0114]), which performs the claimed method of “receiving an order for audio [and/] or video data offered in a video broadcast based on a user selection made while viewing a video broadcast through a video viewing system” as met in one example by user television equipment 22 (Fig. 7), including a set-top box 28, a television 36, and a remote control 40, where a user highlights a program, such as “I Love Lucy” (Fig. 11a), and selects the “record” button on the remote control 40 (also see Figs. 14a-b and pgs. 11-12, ¶ [0133]-[0134]), or by the user highlighting a pay-per-view program listing and pressing “order” or another suitable key on the remote control 40 (see Fig. 15a and pg. 12, ¶ [0138]), or more specifically at the end of ¶ [0133] and the top of page 12, where users may indicate a desire to record a program or group of programs on demand by, for example,

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pressing a "RECORD" key on remote control 40 while watching a program (see pgs. 11-12, ¶'s [0133] - [0134] and Fig. 14a). The claimed, "wherein the step of receiving the order comprises recording a time and channel being viewed by the user," is met by the user indicating a desire to order or record as program, where a record request is transmitted to the appropriate media server, and the record request or order may include information related to the program and the user including the time and channel being viewed by the user (see page 6, ¶ [0087], pages 11-12, ¶'s [0133] - [0134] and page 12, ¶ [0142]). The claimed "transmitting the order from the video viewing to a server and data storage device" is met by the set-top box 28 transmitting the request or order to the remote media server 24, which comprises a server 24 (and 25) and data storage 15 (see Figs. 7 and 2a-2e, and pg. 7, ¶ [0091] for example). The claimed, "matching the recorded time and channel to identify the desired audio or video data," is met by the user indicating a desire to order or record as program, where the set-top box 28 transmits the information or a record request to the head-end and server or appropriate media server, and the information or record request (order) may include information related to the program and the user, including the time and channel being viewed by the user (see pg. 6, ¶ [0087], pg. 7, ¶ [0091], pgs. 11-12, ¶'s [0133] - [0134] and pg. 12, ¶ [0142]), in order to retrieve and transmit the requested audio or video data to the user. The claimed "transmitting the requested audio [and/] or video data to the user in a portable electronic form" is met by the programs or videos may be distributed by distribution equipment 21 to user television equipment 22 in various formats, such as MPEG-2 files, an MPEG-2 data stream, or other formats (see pg. 7, ¶ [0097]).

As to claims 18-20, the claims are rejected based on the same arguments made in the rejection of claims 2, 3 and 5 respectively.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 6-7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ellis et al.

As to claim 4, the Ellis et al reference discloses a method for automatically debiting the user's account (see pg. 12, ¶ [0136]). Ellis et al does not explicitly disclose that "an encrypted credit card or debit card number is recorded along with the time and channel viewed". However, the Examiner takes Official Notice that it is notoriously well known in the art of audio/video distribution and purchasing systems to have the ability to send an encrypted credit or debit card account number along with a time and channel viewed for an order that is to be purchased through the system for the advantage of allowing a user to purchase audio or video data through by using an account or their own choice, and whereby the user's personal account information is protected for their own security through encryption methods for the advantage of preventing hackers or other individuals from stealing the user's personal account information. Therefore, it is submitted that it would have been clearly obvious to one of ordinary skill in the art at the time of the invention to have an encrypted credit card or debit card number recorded along with the time and channel viewed for the advantages given above.

As to claim 6, the Ellis et al reference discloses the method of claim 1 as described above. Ellis et al does not explicitly disclose that a method of transmission is determined by user

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preprogrammed instructions. However, the Examiner takes Official Notice that it is notoriously well known in the art of interactive video distribution systems to have the viewer enter preprogrammed instructions into their system or set-top box, for the advantages of allowing multiple users to access the system according to their own personal settings, and to provide parental control of the system, in addition to, providing the user with quick response time, since the user would not have to set up the method of transmission each time an order is placed by having the method already setup through activating their own identification number. Therefore, it is submitted that it would have been clearly obvious to one of ordinary skill in the art at the time of the invention to have the method of transmission determined by user preprogrammed instructions for the advantages given above.

As to claim 7, the Ellis et al reference discloses the method of claim 3 as described above. Ellis et al does not explicitly disclose that a method of transmission is determined by a user identification number. However, the Examiner takes Official Notice that it is notoriously well known in the art of interactive video distribution systems to have the viewer enter a personal identification number or PIN in order to have access to special settings or privileges, including a method of transmission for ordering a product or service such as audio or video data for the advantages of limiting access only to users who have paid for the service and further preventing hackers from using the system, or to allow for multiple users to access the system according to their own personal settings, and to provide parental control of the system, in addition to, providing the user with quick response time, since the user would not have to set up the method of transmission each time an order is placed by having the method already setup through activating their own identification number. Therefore, it is submitted that it would have been

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clearly obvious to one of ordinary skill in the art at the time of the invention to have the method of transmission determined by a user identification number for the advantages given above.

As to claim 21, the claim is rejected based on the same arguments made in the rejection of claim 6.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael W. Hoyer whose telephone number is (571) 272-7346. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller, can be reached at (571) 272-7353.

Any response to this action should be mailed to:

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Alexandria, VA 22314

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to customer service whose telephone number is (571) 272-2600.

Michael W. Hoyer
March 30, 2005



JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600